

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christopher Voice et al. Examiner: Shin Hon Chen
Serial No.: 10/849,402 Art Unit: 2431
Filing Date: May 19, 2004 Docket No.: 10500.04.0427
Confirmation No.: 6974
Title: **METHOD AND APPARATUS FOR PROVIDING ELECTRONIC MESSAGE
AUTHENTICATION**

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicants respectfully submit that there is a clear error since the Watts reference does not teach what is alleged. Claims 1-8, 10-13, 15-23, 25, 26, 31-33 and 35 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,712,627 (Watts).

Claim 1 cites, among other things:

sending, by the sender unit, data representing an electronic message and sending both the location information and the desired sender authentication information for the recipient.

As such, the claimed method for providing electronic message authentication recites among other things, sending an electronic message and sending both the location information which is the challenge used to find desired sender authentication information that can be located on the article, along with the desired authentication information for the recipient, which is the expected response. Accordingly, the sender unit sends for the recipient a message and also both the challenge and expected response to the recipient. Such a system unlike the Watts system allows a recipient to authenticate a sender unit. Typically, a sender unit only sends a challenge and is expected to receive a response from the recipient back based on the challenge. This latter prior art approach is what is described in Watts. For example, as stated in the Abstract of Watts, a card is distributed to authorized users. The system requests of a person seeking access to the

system, to identify themselves and provide the indicium at a specified one of the addressable positions on the card assigned to identified person. This is the challenge. As such, only a challenge is sent by the system to the user not both the challenge and the corresponding response. There is no sender authentication operation described in the cited portion of Watts. There is clear error since the cited portion of Watts, namely col. 2, lns. 37-64 which has been cited as allegedly teaching "sending, by the sender unit an electronic message in both the location information and the desired sender authentication information for the recipient" (see Final Action page 4), only teaches that an authorized person is provided with a challenge – a row and column address. The person is not also provided with the corresponding response. Applicants have reproduced the cited portion of Watts for convenience below.

Referring now the FIGURE, a security system 10 for determining whether a person seeking access to a secured system, such as a computer, telephone long distance carrier, or building is authorized to obtain such access. The system 10 includes a plurality of identification, or Security cards 12a-12n. Each one of the cards 12a-12n has a plurality of addressable positions, here arranged in rows R_1-R_m and columns C_1-C_n . In the example shown in FIG. 1, $m=8$ and $n=5$. Thus, the cards 12a-12n here have 40 addressable positions. Each one of the addressable positions has a row address R_1-R_m and a column address C_1-C_n . Each one of the addressable positions $R_1.C_1-R_m.C_n$ has an indicium, here a two digit number. Each person allowed access is assigned a corresponding one of the identification cards 12a-12n. The proposed identification cards 12a-12n are printed cards with indicia randomly selected by a computer system. The authorized person may also be given, or have a preassigned, password, and an existing identification number, such as an employee number or a telephone calling card number to identify the person issued the identification card. The organization (requester/caretaker) issuing the cards will determine if: 1) no password is to be used, 2) a password is to be given to the authorized person to memorize at the time of issuance of one of the identification cards 12a-12n, and/or 3) integrate the identification cards 12a-12n into the existing security system in order to provide an additional layer of security protection (i.e. person also has in their possession the issued security card).

As seen, Watts does not teach what is alleged. Due to this clear error, the rejection should be withdrawn.

As to claim 29, the final action fails to consider Applicants' remarks filed in their response filed September 1, 2010. The claimed transaction card includes not only the transaction card serial number information that identifies the transaction card, but also account information and sender authentication information identified by location information wherein the location information is also on the transaction card. As claimed, a unique and low cost transaction card is provided that may be used to facilitate online transactions such as debit card transactions, credit card transactions, banking transactions and other transactions that also employ a low cost sender authentication information mechanism to provide a new type of transaction card not contemplated alone or in combination with Watts. The office action states that "Watts discloses a transaction card comprising: transaction card serial number information (Watts: col. 3, lns. 25-29)" (page 11 of final action). As evident from the below cited portion of Watts, Watts does not teach any transactional card serial number information.

preassigned, memorized password. If the password matches with the identified person's password, then the second criterion is evaluated. Thus, the person seeking access is next asked for the indicium at a specified, randomly chosen one of the, here 40 addressable positions (i.e., at one of the

All that is taught is that there is indicium on a card located at addressable positions such as a row and column. Since Watts does not teach what is alleged, there has been clear error. In addition, there is additional clear error with respect to claim 29 since the rejection states "Watts does not explicitly disclose the card comprise serial number information and account information" (final action, page 11). However, as noted above, the Examiner cites Watts for teaching serial number information yet in the same rejection admits that Watts does not teach

such information. This is clear error. In addition, the rejection alleges that it would have been obvious to include a serial number on the card of Watts. However, the office action does not address the claimed account information on a transaction card. The security card of Watts is merely a user ID card to gain access to a system – it is not a transaction card of any kind. There is no motivation to modify Watts other than from Applicants' own disclosure. Accordingly, Applicants respectfully submit that the rejection should be withdrawn for one or more of the above reasons.

Claim 36 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,246,378 (Goede). The office action cites col. 3, lns. 25-29 of Goede as allegedly teaching transaction card identification information on the transaction card. There has been clear error because Goede does not teach what is alleged. The cited portion of the reference makes no mention of any transaction card identification information but instead the cited portion refers to location designating symbols such as letters disposed in a row as well as numerals. Applicants respectfully note that the claim requires transaction card serial number information that identifies the transaction card. The office action admits that there is not teaching of card serial number information, yet states that the card ID information is taught in col. 3, lns. 25-29. This inconsistency is clear error.

Also, there is no translucent identification member affixed to the transaction card set forth in the cited portion (col. 2, lns. 45-47). Goede teaches that the substrate can be transparent. There is no indication in the office action as to what structure in Goede corresponds to the claimed transaction card as compared to the translucent member that is affixed to the transaction card. The cited portion actually refers to the substrate 12 and not to any translucent

identification member affixed to 12. Applicants respectfully submit that the transaction card cannot be affixed to itself and as such, there has been clear error.

For the above reasons and due to the presence of additional clear error, reconsideration and withdrawal of the rejection of the claims is respectfully requested and a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: April 22, 2011

By: /Christopher J. Reckamp/
Christopher J. Reckamp
Reg. No. 34,414

Vedder Price P.C.
222 North LaSalle Street
Chicago, Illinois 60601
PHONE: (312) 609-7599
FAX: (312) 609-5005